

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 11 and 17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,733,213 to Colarusso (hereinafter "Colarusso").

In response, claims 11 and 17 have been canceled thereby rendering the rejection thereof moot. Claims 12-16, dependent upon claim 11 have also been canceled.

Furthermore, the Examiner rejects claim 20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,597,161 to Bellehumeur et al., (hereinafter "Bellehumeur").

In response, claim 20 has been amended to include the features of dependent claim 21. Consequently, claim 21 has been canceled. The Applicant respectfully submits that claim 20, as amended, is allowable for the same reasons as set forth below with regard to claim 1.

In the Official Action, the Examiner rejects claims 1-3, 5, 6, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Colarusso in view of Bellehumeur. Additionally, the Examiner rejects claims 4, 9, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Colarusso in view of Bellehumeur and further in view of U.S. Patent No. 6,152,842 to Licursi (hereinafter "Licursi"). Furthermore, the Examiner rejects claims 7, 8, and 10 under 35 U.S.C. § 103(a) as being unpatentable over Colarusso in view of Bellehumeur and further in view of U.S. Patent No. 5,816,965 to Kotler (hereinafter "Kotler"). Still further, the Examiner rejects claims 12 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Colarusso in view of Licursi. Yet further, the Examiner rejects claims 14 and 15 under 35 U.S.C. § 103(a)

as being unpatentable over Colarusso in view of Kotler. Lastly, the Examiner rejects claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Licursi.

Before addressing such rejections the Applicant respectfully submits that the puck of the present application, as recited in at least claims 1, 4, 19, and 21 (as amended) provides better stability than hockey pucks of the prior art. The better stability is evident not only when the puck is gliding flat on a surface but also when it is on its edge because the weight distribution of the puck tends to return the puck to a flat orientation on the surface. Hockey pucks of the prior art, such as Colarusso, having only a central plug, address the problem of stability when flat on a surface but are unstable when on their edge. In contrast, hockey pucks of the prior art, such as Bellehumeur, having only peripheral plugs, address the problem of poor stability when on their edge but do not address the stability of the puck when flat on a surface. The hockey puck of the present application, as recited in claims 1 and 21, having both a central and peripheral plugs, makes for a stable puck when flat on a surface and when on its edge, a feature which has been missing from the hockey pucks of the prior art. The features of at least claims 4 and 9 (and 19) add to and enhance such stability of the hockey puck of the present application.

With regard to the rejections of claims 12-16, as discussed above, the same have been canceled, thereby rendering the rejections thereof moot.

With regard to claim 1, the Applicant respectfully disagrees with the Examiner's argument regarding the motivation and suggestion to combine the teachings of Colarusso and Bellehumeur.

The Examiner argues that "it would have been obvious to one of ordinary skill in the art to place a single plug in each of the peripheral openings in view of Bellehumeur

who teaches, in Figures 7-10 and 15-17, the equivalence between discrete and separate plugs in a hockey puck."

Firstly, the Examiner's argument is fatally flawed because the Examiner fails to consider whether it would have been obvious to one of ordinary skill in the art **at the time of the invention**. The Examiner makes no showing of the level of skill in the art at the time of the invention any why such a combination would have been obvious to one of ordinary skill in the art at that time. Such a showing is required by the Court of Appeals for the Federal Circuit (See e.g., In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998) and In re Dembiczak, 50 USPQ2d 1614, 1618 (Fed. Cir., April 28, 1999)).

Secondly, the Examiner does not make a showing of a specific motivation or suggestion why one of ordinary skill in the art at the time of the invention would use the peripheral plugs of Bellehumeur in the openings of Colarusso. The Examiner basically argues that it would be obvious to place the peripheral plugs of Bellehumeur in the openings of Colarusso because Colarusso teaches openings and Bellehumeur teaches peripheral plugs. The Examiner has not identified any teachings in the references themselves which would suggest their combination. Where a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the missing feature. Al-Site Corp. v. VSI International Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment).

Therefore, the Applicant respectfully submits that the Examiner, without identifying a suggestion, motivation, or teaching for combining the references, has used impermissible hindsight to reject claim 1 under 35 U.S.C. 103(a). The Federal Circuit in In re

Rouffet stated that virtually all inventions are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references that create the case of obviousness. Applicant respectfully submits that the Examiner has not met this burden.

In light of the state of the law as set forth by the Federal Circuit and the Examiner's lack of specificity with regard to the motivation to combine the cited references, the Applicant respectfully submits that the rejection of claim 1 for obviousness under 35 U.S.C. 103(a) lacks the requisite motivation and must be withdrawn.

As further proof of nonobviousness, Applicant attaches hereto Affidavits under 37 C.F.R. 1.132 showing secondary considerations of nonobviousness. Specifically, the hockey puck of claim 1 has been met with commercial success and solves a long-felt need in the art. The Applicant respectfully submits that claim 20, as amended, is allowable for at least the same reasons as claim 1. Furthermore, claims 2-10, being dependent from claim 1, are at least allowable as depending from an allowable base claim.

With regard to claims 4, 9, and 19, the Applicant again respectfully disagrees with the Examiner's argument regarding the motivation and suggestion to combine the teachings of Colarusso, Bellehumeur, and Licursi.

The Examiner argues that "it would have been obvious to one of ordinary skill in the art to size the peripheral plugs to cover a substantial portion of the puck periphery in view of Licursi who teaches that such a construction allows for better puck stability over an irregular surface."

Firstly, the Examiner's argument is fatally flawed as discussed above because the Examiner fails to consider whether it would have been obvious to one of ordinary skill in the art at the time of the invention.

Secondly, the Examiner again does not make a showing of a specific motivation or suggestion why one of ordinary skill in the art at the time of the invention would combine the teachings of Bellehumeur and Colarusso with Licursi. The Examiner has not identified any teachings in the references themselves that would suggest their combination. Where a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the missing feature. (Al-Site Corp.). Furthermore, the Examiner argues that Licursi teaches such a construction allows for better puck stability over an irregular surface. The Applicant respectfully submits that no such teaching appears in Licursi. Licursi teaches a construction which provides a smoother glide over an irregular surface. Licursi does not teach that such construction makes for a more stable puck either when the puck is gliding or when it is on its edge.

Therefore, the Applicant respectfully submits that the Examiner, without identifying a suggestion, motivation, or teaching for combining the references, has used impermissible hindsight to reject claims 4, 9, and 19 under 35 U.S.C. 103(a).

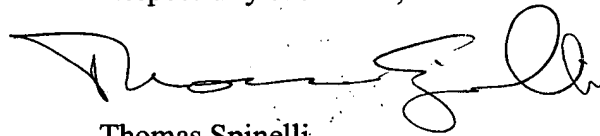
In light of the state of the law as set forth by the Federal Circuit and the Examiner's lack of specificity with regard to the motivation to combine the cited references, the applicant respectfully submits that the rejection of claims 4, 9, and 19 for obviousness under 35 U.S.C. 103(a) lacks the requisite motivation and must be withdrawn.

As further proof of nonobviousness, Applicant attaches hereto Affidavits under 37 C.F.R. 1.132 showing secondary considerations of nonobviousness. Specifically, the hockey puck of claims 4, 9, and 19 has been met with commercial success and solves a long-felt need in the art.

Accordingly, claim 18 has been amended to include the features of claim 19. The Applicant respectfully submits that claim 18 is allowable for at least the reasons set forth above.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas Spinelli', with a stylized flourish at the end.

Thomas Spinelli
Registration No. 39,533

Scully, Scott, Murphy & Presser
400 Garden City Plaza - Ste. 300
Garden City, New York 11530
(516) 742-4343
TS/cm/jam

Enclosures (Affidavits Under 37 C.F.R. 1.132)